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09/755,650	01/05/2001	Brett B. Stewart	5285-00106	7041

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EXAMINER

MYHRE, JAMES W

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 01/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/755,650**

Applicant(s)  
**Stewart**

Examiner  
**James W. Myhre**

Art Unit  
**3622**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Dec 2, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-13, 15-23, 26-36, and 38-45 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-13, 15-23, 26-36, and 38-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 2, 2002 has been entered.

### ***Response to Amendment***

2. The Supplemental Amendment filed on December 2, 2002 has been considered but is ineffective to overcome the Lawlor et al (6,202,054), Rudow et al (6,236,360), and Farmakis et al (5,714,948) references. No claims were amended; however, a copy of the previous rejection of all claims is presented below for the Applicant's convenience.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 7-9, 13, 15-17, 21-23, 26-28, 31, 32, 34-36, 38, 39, and 42-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lawlor et al (6,202,054).

Claims 1, 13, 23, 39, 42, and 43: Lawlor discloses a system and method for providing information to users of mobile (portable) units, comprising:

a. Transmitting identification information from the mobile unit to an access point (col 34, lines 57-64);

b. Detecting the mobile unit by the access point based on the identification information transmitted by the mobile unit (col 34, line 64 - col 35, line 5);

c. Determine past transactions of the user of the mobile unit (col 13, lines 42-59; col 15, lines 36-49; col 30, line 55 - col 31, line 15; and col 39, lines 5-29); and

d. Transmitting information to the mobile unit based/dependent upon the past transaction information of the user of the mobile unit (col 13, lines 42-59; col 15, lines 36-49; col 30, line 55 - col 31, line 15; and col 39, lines 5-29).

Lawlor explicitly discloses that the remote terminal is portable. For example, the remote terminal is described as: "One version of the preferred embodiment terminal is compact in size (3.75"x8"x1.75"), portable and simply connects to the user's telephone jack" (col 7, lines 59-62); "The terminal provided by the preferred embodiment of the present invention is compact and

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portable and is available for use twenty-four hours a day” (col 10, lines 17-19); and “The terminal is compact, 8 inches wide by 5.75 inches and 1.75 inches high with the telephone handset. The compact non-telephone model is 8 inches wide by 3.75 inches deep by 1.75 inches high. The compact model can easily slip into a pocket or briefcase, and is approximately 53 cubic inches and weighs less than one pound” (col 13, lines 5-10). However, while Lawlor discloses that the remote terminal may be used as a regular telephone in addition to the remote banking services, it is not explicitly disclosed that the telephone is a wireless telephone, i.e. cellular phone. The Examiner notes that wireless telephone (cordless phones) have been in use within the United States for several decades at the least, and cellular phones have been in use since the early 1990's. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use one of the known wireless telephones as the remote terminal which dials into the telephone network in Lawlor. One would have been motivated to use a wireless telephone to allow the user to move freely about the location and not be tied down to a specific location, such as their kitchen or receptionist area, which may not be convenient or secure places to conduct their banking transactions. These were the driving motivations in the development of wireless phones systems throughout the 1960's and 70's.

Claims 2, 15, 26, and 44: Lawlor discloses a system and method for providing information to users of mobile (portable) units as in Claims 1, 13, 23, and 43 above; and further discloses that the past transactions include the requirements, preferences and/or habits of the user (col 15, lines 36-49; col 30, line 55 - col 31, line 15; and col 39, lines 5-29).

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Claims 3, 16, and 27: Lawlor discloses a system and method for providing information to users of mobile (portable) units as in Claims 1, 13, and 23 above; and further discloses that the past transaction information includes information from which probable future actions by the users may be extrapolated (col 30, line 50 - col 31, line 15 and col 39, lines 5-29). Lawlor discloses the past transaction information including information such as the user's spending patterns. Spending pattern information is used extensively by the retail arts to project future spending by the individual. Therefore, the inclusion of this type of information in Lawlor reads on the above limitation.

Claims 4, 17, 28, and 45: Lawlor disclose a system and method for providing information to users of mobile (portable) units as in Claims 1, 13, 23, and 43 above; and further discloses that the past transaction information includes information about past commercial activities of the user (col 15, lines 36-49 and col 30, line 55 - col 31, line 15).

Claims 7 and 8: Lawlor discloses a system and method for providing information to users of mobile (portable) units as in Claim 1 above; and further discloses a plurality of information providers who provide the information based on the past transactions of the user (col 17, lines 62-67 and col 18, lines 12-17).

Claim 9: Lawlor discloses a system and method for providing information to users of mobile (portable) units as in Claim 8 above, and further discloses that the advertisement (information) could be for a loan (i.e. from a bank or financial institution) or "used to advertise any good or service." (col 39, lines 13-22).

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Claims 21, 22, 34, 35, 36, and 38: Lawlor discloses a system and method for providing information to users of mobile (portable) units as in Claims 13 and 23 above; and further discloses that the information comprises promotions/advertisements based on the past transactions of the user (col 13, lines 42-59; col 15, lines 36-49; and col 30, line 50 - col 31, line 15).

Claim 31: Lawlor discloses a system and method for providing information to users of mobile (portable) units as in Claim 23 above, and further discloses the user of the mobile device transmitting an inquiry and the information provider transmitting information in response to the inquiry (col 15, lines 36-49; col 30, line 55 - col 31, line 15; and col 33, lines 58-66).

Claim 32: Lawlor discloses a system and method for providing information to users of mobile (portable) units as in Claim 23 above, and further discloses the information provider determines if a service is required and provides the service to the user upon detection of the user within the monitored area (col 15, lines 36-49; col 30, line 55 - col 31, line 15; col 33, lines 58-66; and col 50, lines 50-60).

5. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lawlor et al (6,202,054) as applied to Claim 1 above, and further in view of Rudow et al (6,236,360).

Claims 11 and 12: Lawlor discloses a system and method for providing information to users of mobile (portable) units as in Claim 1 above, but does not explicitly disclose that the information is dependent upon the location of the mobile unit which is determined by the arrangement of the access points. Rudow discloses a similar system of providing information to

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golfers on a golf course which uses the Global Positioning Satellite (GPS) system and local transceivers to determine the exact location of the golf cart (or hand held device) on the golf course and then transmits information (such as distance to hole, recommended golf club to use, etc.) to the golfer based on the location of the golf cart (col 6, lines 53-55). The system also can be used to transmit other information to the golfer, such as advertisements and personal messages. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to determine the location from which the portable device in Lawlor is transmitting and to base the information transmitted to the device on the location. One would have been motivated to base the transmitted information on the location of the portable device in order to better target the advertisement to the user as described by Lawlor (col 30, line 55 - col 31, line 15).

6. Claims 5, 6, 18-20, 29, 30, 33, 40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lawlor et al (6,202,054) in view of Farmakis et al (5,714,948).

Claims 5, 6, 18-20, 29, 30, 33, 40, and 41: Lawlor disclose a system and method for providing information to users of mobile (portable) units as in Claims 1, 13, 23, and 39 above, and further discloses the information being advertisements pertaining to banking services, loans, or any other good or service as discussed in Claim 9 above. However, Lawlor does not explicitly disclose where the access points are located or that the information is a travel itinerary. Farmakis discloses a similar system and method for providing information to users of mobile units (col 4,



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lines 32-35; col 9, lines 60-62; and col 16, line 67 - col 17, line 10) in which the access points are located in an airport (col 13, lines 7-33). It would have been obvious to one having ordinary skill in the art at the time the invention was made that the location of the access points and information provided would depend on the type of information providers in the system. In Rudow, the access points are located around the golf course and the information being provided pertains to the golfer's game (i.e. distance from hole, etc.) or related advertisements/services (i.e. golf ball sale in clubhouse or personal message to golfer). In Farmakis the access points are located around an airport and the information being provided pertains to pilot instructions and information related to traffic control, both on the ground and in the air. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to locate the access points in particular areas, such as airports or hotels, and to provide information about goods or services of the information providers, such as travel agencies/airlines (travel itineraries), hotel or car rental information/reservations, etc. One would have been motivated to locate the access points in airports or hotels in order to target customers of such establishments, especially if the information provider was the hotel, an airline, car rental agency, or taxi service.

### ***Response to Arguments***

7. Applicant's arguments filed December 2, 2002 have been fully considered but they are not persuasive.

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A. The Applicant argues that Lawlor does not disclose and that it would not have been obvious to include a wireless mobile unit communicating with wireless access points (pages 2-3). The Examiner notes that in the final rejection and repeated in the above rejection Lawlor discloses using a portable device that can connect to the telephone system. While Lawlor does not disclose that the telephone device could be a wireless telephone or cellular telephone, these products are very well known throughout society and either would have been an obvious choice for the telephone device. The Applicant argues that the Lawlor system “could not be readily modified to address a wireless network system” (page 3). However, wireless telephone systems (i.e. cellular telephone networks) are pervasive throughout the United States and much of the rest of the world. No modification would be required to Lawlor’s system with the exception of purchasing any of the myriad of wireless or cellular telephones that were available on the market at the time the invention was made.

B. The Applicant also argues that Lawlor does not disclose that the access points are located in airports or hotels as in Claims 5 and 6. The Examiner has cited two references which disclose wireless access points in these locations. Furthermore, wireless access points for the cellular telephone systems are located in or near all major locations within the country, to include airports, hotels, resorts, recreation areas, train tracks, business districts, residential areas, major highways, and other areas with consistent user traffic. Therefore, it would have been obvious to locate the access points in Lawlor to any or all of these locations, even without citing the additional references.

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***Conclusion***

8. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

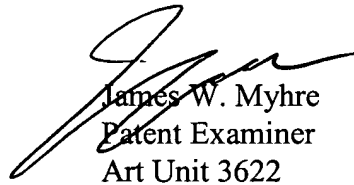
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9326. Draft or Informal faxes may be submitted to (703) 872-9327 or directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.



January 14, 2003



James W. Myhre  
Patent Examiner  
Art Unit 3622